

even though it includes claims to distinct or independent inventions." Manual of Patent Examining Procedure § 803 (8th ed. August 2001) (emphasis added).

Applicants submit that all the pending claims are directed to pharmaceutical compositions comprising or methods of preparing or using venlafaxine derivatives. Thus, derivatives of venlafaxine are present in all of the claims. Therefore, even if Applicants were to elect one of the groups, the required search would necessarily encompass the subject matter of the other groups. Applicants therefore respectfully submit that a search of all of Groups I-V would not impose a "serious burden" on the Examiner. Applicants, therefore, respectfully request that the restriction of the claims be reconsidered and withdrawn.

In the alternative, Applicants respectfully request that the Examiner allow the prosecution of at least Groups I and V, claims 1-16 and 22-59, together. These claims are directed to pharmaceutical compositions comprising or methods of using venlafaxine derivatives. Applicants respectfully disagree with the Examiner's conclusion that the process for using the product as claimed can be practiced with another materially different product. This is because the claimed methods recite the use of venlafaxine derivatives, not the use of other compounds, such as venlafaxine. The claimed methods therefore cannot be performed without venlafaxine derivatives. For this reason, Applicants respectfully request that claims 1-16 and 22-59 be examined together.

On page 3 of the Office Action, it is alleged that the pending claims are directed to more than one species of the generic invention, and that the Applicants are required to elect a single species. The Examiner, however, does not specifically define the alleged species. In order to be fully responsive, Applicants provisionally elect, with traverse, (\pm)-O-desmethylvenlafaxine as the species for searching purposes.

In summary, Applicants have demonstrated that the subject matter of the claims of Groups I-V should be examined together, and respectfully request therefore that the restriction requirement be withdrawn. Should the Examiner disagree, Applicants request that at least the claims of Groups I and V, claims 1-26 and 22-59, be searched and examined together.

Applicants reserve the right to petition from the restriction requirement under 37 C.F.R. § 1.144. In addition, Applicants reserve their rights to file divisional applications for the non-elected claims, as well as any other matter disclosed in the present application which is not encompassed by the elected claims.

No fee is believed to be due for the submission of this response. Should any fees be required, however, please charge such fees to Pennie & Edmonds LLP Deposit Account No. 16-1150.

Respectfully submitted,

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 45,479
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Enclosures